

## **Remarks**

The Office Action dated May 23, 2005 rejected claims 1-10, 13-26, and 28-39 of U.S. Patent Application No 2005/0132288 to Kirn, *et al* (“Kirn”) under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2005/0052685 to Herf, *et al* (“Herf”). Also, the Office Action further rejected claims 11, 12, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Herf in view of U.S. Patent No. 6,674,992 to Helmick, *et al* (“Helmick”). By virtue of this amendment, claims 1, 6, 12, 18, and 32 have been amended. Accordingly, claims 1-39 are pending herein. Entry of this amendment, reconsideration of the claims and allowance of this application are respectfully requested.

## **Claim Objection**

Claim 12 was objected to because the phrase “ . . . system according to claim 12” should be changed to “system according to claim 11.” Claim 12 has been amended accordingly.

## **35 U.S.C. §102(e) Rejections**

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdeggal Brothers v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989). *See also*, MPEP §2131. As Herf fails to describe, either expressly or inherently, each and every element as set forth in the rejected claims, Applicants traverse this rejection.

Claim 1 recites a messaging system consisting of a messaging client which presents a dialog interface to at least two participating users. In conjunction, the system also includes a media viewer that communicates with the messaging client and allows at least one

controlling user to selectively present media objects to other users. According to claim 1, as amended herein, the inventive system transmits objects between users by “executing multiple routines in parallel.” For example, in embodiments, the system could transmit objects by simultaneously converting, transferring, and loading them between users. *See* Kirn, Specifications, para. 0021.

The Office Action rejected independent claims 1 and 18, citing Herf for teaching an image sharing application that “automatically” transfers images. However, Herf fails to disclose a method or system that transmits media objects by executing multiple routines in parallel. Instead, Herf teaches that image transmission is performed using a “hybrid push-pull” method. *See* Herf, Specifications, paras. 0032, 0046-0048, 0078. In order for images to be transmitted to other users under the “push-pull” method, a number of steps must occur in sequence. Once images are selected by a sending user and a send function is activated, permission data must first be sent (or “pushed”) over the network to the receiving user. Herf, Specifications, para. 0046. Once permission data is delivered to the receiving user, a request from the receiving user is sent back to the sending user for the specified image or images. Herf, Specifications, para. 0048. Then, the sending user responds to the receiving user’s request by transmitting the image data. Herf, Specifications, para. 0048. In other words, the receiving user “pulls” the image from the sending user by submitting requests that are eventually fulfilled. Herf’s method requires sequential steps and should not be construed as a method for “automatically” transferring images.

By way of contrast, claims 1 and 18, as amended herein, recite a system and a method to transmit images by executing multiple routines contemporaneously. Neither uses a “push-pull” method as described in Herf. Rather, claim 1 states that “the presentation of shared

media objects is performed using multiple routines executed in parallel.” Additionally, claim 18 also states that media objects are selectively presented to other users “using multiple routines executed in parallel to transmit the shared media objects.” In embodiments, Kirn teaches that media objects can be simultaneously converted, transferred, and loaded to accomplish image transmission. *See* Kirn, Specifications, paras. 0021-0023. Therefore, Herf cannot support the rejection of claims 1 and 18 because Herf fails to identically describe, either expressly or inherently, a method or a system that transmits media objects by contemporaneously executed routines. Lacking these and other recited features, the rejection of claims 1 and 18 under § 102 as being anticipated by Herf are overcome.

The Office Action also rejected claims 2-10, 13-26, and 28-31 as being anticipated by Herf under § 102. Claims 2-10 and 13-17 depend from claim 1 and distinguish over Herf for the aforementioned reasons as claim 1, as well as further limitations recited therein. Furthermore, claims 19-26 and 28-31 depend from claim 18 and distinguish over Herf for the aforementioned reasons as claim 18, as well as further limitations recited therein.

The Office Action rejected claim 32 citing Herf for teaching “an interface that enables a sender user to control selection and transmission of media objects for mutual viewing by others.” As mentioned above, Herf discloses a method of sharing media objects between users by transmitting the images using a “hybrid push-pull” method. In order for images to be transmitted to other users under the “push-pull” method, a number of steps must occur in sequence. Once images are selected by a sending user and a send function is activated, permission data must first be sent (or “pushed”) over the network to the receiving user. *See* Herf, Specifications, para. 0046. Once permission data is delivered to the receiving user, a request from the receiving user is sent back to the sending user for the specified image or images.

Herf, Specifications, para. 0048. Then, the sending user responds to the receiving user's request by transmitting the image data. *See* Herf, Specifications, para. 0048. In other words, the receiving user essentially "pulls" the image from the sending user by submitting requests that are eventually fulfilled.

Claim 32, as amended herein, recites a method that transmits images by "executing multiple routines in parallel." Claim 32 does not use a "push-pull" method to transmit images. Rather, in embodiments, media objects can simultaneously be converted, transferred, and loaded to accomplish image transmission. *See* Kirn, Specifications, paras. 0021-0023. Therefore, Herf cannot support the rejection of claims 32 because Herf fails to identically describe, either expressly or inherently, a method that transmits media objects by contemporaneously executing routines. Lacking these and other recited features, the rejection of claim 32 under § 102 as being anticipated by Herf is overcome.

Claims 33-39 depend from claim 32 and define over Herf for the aforementioned reasons, as well as further limitations recited therein. Specifically, claim 37 is allowable because Herf fails to teach a method utilizing "a transmissible control object that allows at least one of the users to maintain or a combination of users to share control of the set of shared media objects selectively presented in the media viewer." Herf is cited for teaching "a user interface that enables a user to maintain control of the media viewer." Yet, Herf merely allows a sending user to control the selection of images to transmit to the receiving user. Whereas, claim 37 teaches a control object that can be passed or shared between users allowing them to control the display of shared images. *See* Herf, Specifications, paras. 0014, 0019. Herf does not disclose any such method for sharing control of the media viewer. Lacking these and other recited features, the rejection of claim 37 under as being anticipated by Herf is overcome.

### **35 U.S.C. § 103(a) Rejections**

The basic requirements of a *prima facie* case of obviousness are summarized in MPEP § 2143 through § 2143.04. In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success in combining the references. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See also* MPEP § 2143.

Further, in establishing a *prima facie* case of obviousness, the initial burden is placed on the Examiner. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972 (Bd. Pat App. & Inter. 1985). *Id. See also* MPEP §§ 706.02(j), 2142.

The Office Action rejected claims 11 and 27 as being rendered obvious under 35 U.S.C. § 103(a) by Herf in view of Helmick. Claims 11 and 27 both recite methods for a user to place annotation objects on images that are being shared between two users via a media viewer. Herf fails to teach that an annotation object can be presented via a media viewer. Helmick discloses an online document sharing platform for educational purposes. The Office Action

combines the two by extending Helmick's document sharing, journal, and notebook functions to Herf's transmission of images via a media viewer. However, Helmick's document sharing function only allows for manipulation of documents uploaded to a course website. It fails to disclose a method or system for annotating a "set of shared media objects" which are "selectable for selective display to at least one other user by the user having control." Moreover, the journal and notebook functions only allow users to submit information to a course website for storage. Neither the journal or notebook functions allow for the attachment of annotations to media objects. Therefore, an extension of Helmick to Herf would not have made the claimed invention obvious. Lacking these and recited features of the claimed invention, claims 11 and 27 distinguish over the nominal combination of Herf and Helmick, and the rejections of claims 11 and 27 are overcome.

The Office Action also rejected claim 12 as being anticipated by Herf in view of Helmick under § 103. Claim 12, as amended herein, depends from claim 11 and distinguishes over the nominal combination of Herf and Helmick for the aforementioned reasons as claim 11, as well as further limitations recited therein. Therefore, the rejection of claim 12 is overcome.

**Conclusion**

For at least the reasons stated above, claims 1-39 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejection and allowance of claims 1-39. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. It is believed that no fee is due in conjunction with the present amendment. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,



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